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Appl. No.: 10/521,822

Reply to Office Action of: 12/19/2006

REMARKS

Claims 1-10 were allowed.

Claim 11 was rejected under 35 U.S.C. §103(a) as being unpatentable over Bickley et al. (US 5,430,441). The examiner is requested to reconsider this rejection.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In *re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Applicant has amended claim 11 to recite, *inter alia*, "A radio frequency identification (RFID) tag comprising: ... a sole single loop antenna". In contrast, Bickley merely discloses a transponding tag 14 "including a top antenna 22 and a bottom antenna 24" (see col. 4, lines 32-34 and Figs. 3-5). There is no disclosure or suggestion in Bickley to provide a transponding tag having a sole single loop antenna. Just the opposite, in order for the transponding tag 14 to reliably operate, an electrical circuit 34 and a capacitor 44 must be located between the two antennas 22, 24. "The relatively large, planar, spaced apart, conductive layers which form antennae 22 and 24 exhibit a capacitance therebetween which ... stores DC energy to aid in the operation of electrical circuit 34 (e.g., supply current therefor) ... [i]n addition, it [the two antennas 22, 24] shields electrical circuit 34 and capacitor 44 from RF energy, such as interrogation signals" (see col. 5, lines 14-21). Bickley does not teach or suggest a tag comprising a sole single loop antenna (as this would

Appl. No.: 10/521,822
Reply to Office Action of: 12/19/2006

render Bickley inoperative) as claimed in applicant's claimed invention.

The examiner states that "the antenna element is a closed element and therefore a skilled artisan would have found it to be obvious that a loop antenna is formed and defined in the art". Applicant submits that the proposed combination would render a transponding tag having two single loop antennas, as opposed to applicant's claimed invention having "a sole single loop antenna".

Furthermore, applicant submits that there is no suggestion to combine the reference and art as the examiner is attempting to do. In particular, when one is faced with the problem of providing a reduced size antenna having a high capacitance capacitor, there is no incentive for the skilled artisan to propose antennas as suggested by Bickley. As the teachings of Bickley inherently provide for an increased size/thickness due to the configuration of the electrical components (i.e. circuit 34, capacitor 44, inductive pickup coil 46, etc.) disposed between the antennas 22, 24.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. (see MPEP 2143.01, page 2100-98, column 1). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination (see

Appl. No.: 10/521,822
Reply to Office Action of: 12/19/2006

MPEP 2143.01, page 2100-98, column 2). A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is **not sufficient** to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. (see MPEP 2143.01, page 2100-99, column 1) Ex parte Levensgood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). >See also Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.)

In the present case, there is no teaching, suggestion, or motivation, found in the reference or in the knowledge generally available to one of ordinary skill in the art, to provide an RFID tag comprising "a first insulating support, a sole single loop antenna formed on a surface of the first insulating support and including a first and a second contact zone, the first contact zone being connected to a lower electrode ... a second insulating film positioned on top of the lower electrode ... and an upper electrode formed on top of the insulating film and connected to the second contact zone, wherein the sole single loop antenna, the lower electrode, the upper electrode, and the second insulating film are printed by gravure printing" as claimed in amended claim 11. The features of claim 11 are not disclosed or suggested in the art of record. Therefore, claim 11 is patentable and should be allowed.

Appl. No.: 10/521,822
Reply to Office Action of: 12/19/2006

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issue remain, the examiner is invited to call applicant's attorney at the telephone number indicated below.

Respectfully submitted,

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3/19/07

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March 19 2007

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